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10/613,392

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Ronald J. Rosenberger

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

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DELIVERY MODE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/613,392

## Applicant(s)

ROSENBERGER, RONALD J.

## Examiner

Donald L. Champagne

## Art Unit

3688

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 14, 15, 20, 43 and 48-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 14, 15, 20, 43 and 48-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1, 14, 15, 20, 43 and 48-50 are rejected under 35 U.S.C. 101 because the claimed invention is not directed to statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1) be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 70 (1972); *Diamond v. Diehr*, 450 U.S. 192 (1981); *Parker v. Flook*, 437 U.S. 589 n.9 (1978); and *Cochrane v. Deener*, 94 U.S. 780, 788 (1876)). Furthermore, the Supreme Court held that the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (*Benson*, 409 U.S. 71-72). The involvement of the machine or transformation must not merely be insignificant extra-solution activity (*Flook*, 437 U.S. 590).
3. The instant claims fail to meet this test. The claims do not transform a particular article into a different state or thing. The claims are tied to a machine or apparatus, a "computer readable medium" (claim 1 line 5), but this does not does not qualify as a *specific* machine and does not impose a *meaningful* limitation. Said medium is only used for input and output, which is not regarded as merely be insignificant extra-solution activity. This rejection also applies to claims 43 and 48-50, which, while drawn nominally to a "network", have no structure other than that provided by recitation of the corresponding process claim steps.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 14, 15, 20, 43 and 48-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject

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matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A - In each independent claim 1 and 43 (e.g., claim 1 lines 6-7), a "financial card institution network" is new matter.

B - At the end of each independent claim, "wherein said merchant does not co-brand a financial card with said financial card institution or wherein said merchant does not issue or sponsor a private label credit card" is new matter.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 14, 15, 20, 43 and 48-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The distinction between "merchant", which is interpreted as a synonym for "promoter" in the spec., and "financial card institution network" or "financial card institution", which is interpreted as the specification's "product or service offering entity", is indefinite.
8. The claimed promoter and institution/network are interpreted to be distinguished by ownership. Ownership is inherently indefinite because it is itself not concrete (predictable) and precludes a result which is not concrete. The US Supreme Court has ruled that "A corporation is an artificial being, invisible, intangible and existing only in contemplation of law." *CTS Corp. v. Dynamics Corp. of America*, 481 U.S. 69, 89, 107 S. Ct. 1637, 1649-1650 (1987) (citing *Trustees of Dartmouth College v. Woodward*, 17 U.S. (4 Wheat) 518 (1819)). A business entity can be created, merged, dispersed or destroyed at human whim. Hence, in accordance with the *State Street* decision (MPEP 2106.II.A), ownership language cannot impart patentability.
9. At the end of each independent claim, "wherein said merchant does not co-brand a financial card with said financial card institution or wherein said merchant does not issue or sponsor a private label credit card" is indefinite. "Co-branding" and "private label" are ownership distinctions, which are inherently indefinite (para. 8 above).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 14, 15, 20, 43 and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manchester et al (US 20030204470A1, hereafter "Manchester").
12. Manchester teaches (independent claims 1 and 43) a system and method, the method comprising:

(d. and e.) distributing credit card account applications containing (comprising) a merchant code (*merchant number*) to users, and processing completed/redeemed applications comprising said merchant code/*merchant number* (para. [0017] and [0018]);

f. establishing said accounts for said end users (*issues the credit card 16 to the applicant*) based on said processing of said redeemed account applications comprising said merchant code (para. [0017]); and

g. issuing communications to said end users of said accounts (*merchant promotional material*, para. [0012], and *provide marketing information*, para. [0024]) where said communications comprise said advertisements (*the merchant promotional material and marketing information*),

where said communications/advertisements inherently reads on (a.) providing a computer readable file accessible by a financial card institution network comprising said advertisements for said merchant.

13. Manchester does not teach (b.) storing said file on a computer readable medium and (c.) providing a merchant code that cross references said merchant code to said file information on a computer readable medium. However, under *KSR v. Teleflex* (82 USPQ 2nd 1385), it would have been obvious to add these features to the teachings of Manchester because prior art elements are being combined according to known methods to yield predictable results. Manchester teaches every feature of the claims except storing said ad files on a

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computer readable medium cross-referenced to the merchant code. The cross-reference to the merchant code is obvious, and indeed necessary, in order to send the correct ad to the merchant's customers. Putting the ad on a computer readable medium was an obvious, and again virtually necessary step at the time of the instant invention, in order to print or display the ad with the customer statements.

14. The following claim language is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01 and 706.03(a)A):

"wherein said merchant does not co-brand a financial card with said financial card institution or wherein said merchant does not issue or sponsor a private label credit card".

First, "co-branded" and "private label" is not functional language first because it is printed matter, merely words or symbols on a card. Second, this language is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention. To be functional, process steps must be significantly tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (*In re Bilski*, No. 2007-1130, \_F.3d\_, 2008 WL4757). "co-branded" and "private label" does neither.

15. For claims 14 and 48, the ads are issued by the financial card institution so it is obvious that said institution would decide how long they should run. For claims 20 and 50, the ads promote the merchant, so it is obvious that said merchant would decide their content (information). The fees (claims 15 and 49) would be obvious when the financial card institution provided said file maintenance services to the merchant.

### ***Response to Arguments***

16. Applicant's arguments filed 28 May 2009 have been fully considered and addressed in the revised rejection.

### ***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is 571-272-6717. The examiner can normally be reached Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and informal fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
20. The examiner's supervisor, Robert Weinhardt, can be reached on 571-272-6633.
21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
22. **AFTER FINAL INTERVIEW PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

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23. Applicant may have after final arguments considered and amendments entered by filing an RCE.
24. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).

15 August 2009

/Donald L. Champagne/  
Primary Examiner, Art Unit 3688